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WIENER, ERIC A				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/719,317

**Applicant(s)**

RAO, SUMITA

**Examiner**

Eric Wiener

**Art Unit**

2179

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 19 September 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 28-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 28-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/CDC)
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date: \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date: \_\_\_\_\_

**DETAILED ACTION**

***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 9/19/2008 has been entered.
2. Claims 28 – 30 are pending. Claim 30 is new. Claims 28 – 30 are the independent claims. Claims 1 – 27 have been cancelled. Claims 28 – 30 have been rejected by the Examiner.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.
4. Claims 28 and 29 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention.

As per independent claims 28 and 29, paragraph [0054] of the Specification describes that “an association can be made on the local device between the media presentation and a particular trigger event” wherein “upon occurrence of the trigger event, the media presentation may be displayed on the local device.” In addition, paragraph [0054] goes on to state that “the media presentation may be published wirelessly or through network connection to a remote device” and “provided the remote device has a properly configured media engine, the media presentation may be played remotely.” However, nowhere in the Specification is it described that a media presentation is played on a second or a remote device in response to *a trigger event detected on a first or a local device*, as claimed in various similar language in claims 28 and 29. Therefore, claims 28 and 29 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 28 and 29 are rejected under 35 U.S.C. 102(e) as being anticipated by Kirby et al. (US 2004/0165006 A1).

**As per independent claim 28**, Kirby discloses *a method for playing a media presentation on a second handheld wireless communication device in response to a trigger event on a first handheld wireless communication device ([0006]), the method comprising:*

- *generating a media presentation comprising different media objects on a first handheld wireless communication device ([0011], lines 1 – 5),*
- *associating the media presentation with a trigger event on the first handheld wireless communication device; publishing the media presentation to a second handheld wireless communication device; monitoring for the trigger event on the first handheld wireless communication device; detecting the trigger event on the first handheld wireless communication device; and playing the media presentation on the second handheld wireless communication device in response to the trigger event detected on the first handheld wireless communication device [0011] and [0016],*  
*wherein it has been interpreted that the receipt of a command sufficiently serves as a triggering event, because it triggers the display/presentation of content as a response to the received command, further wherein the fact that said commands can be received from remote sources to control the presentation of media on different displays of different devices sufficiently serves to play a media presentation on a second handheld wireless communication device in response to a trigger event on a first handheld wireless communication device.*

**As per independent claim 29,** Kirby discloses *a method for playing a media presentation on a second handheld wireless communication device in response to a trigger event on a first handheld wireless communication device ([0006]), the method comprising:*

- *generating a media presentation comprising different media objects on a first handheld wireless communication device ([0011], lines 1 – 5),*

- *associating the media presentation with at least one trigger event on the first handheld wireless communication device ([0011], lines 5 – 13),*
- *storing the media presentation associated with the at least one trigger event in a storage medium coupled to the first handheld wireless device [0012] – [0013]).*
- *generating a link to a list on the first handheld wireless communication device to each of the different media objects of the media presentation stored in the storage medium; publishing the link to a second handheld wireless communication device; monitoring for the trigger event on the first handheld wireless communication device; detecting the trigger event on the first handheld wireless communication device; and playing the media presentation on the second handheld wireless communication device in response to the trigger event detected on the first handheld wireless communication device [0011] and [0016], wherein it has been interpreted that the receipt of a command sufficiently serves as a triggering event, because it triggers the display/presentation of content as a response to the received command, further wherein the fact that said commands can be received from remote sources to control the presentation of media on different displays of different devices sufficiently serves to play a media presentation on a second handheld wireless communication device in response to a trigger event on a first handheld wireless communication device.*

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claim 30 is rejected under 35 U.S.C. 103(a) as being unpatentable over Noesgaard et al. (US 7,113,809 B2) in view of Haller et al. (US 6,909,878 B2).

**As per independent claim 30**, Noesgaard discloses *a method for arranging and playing a media presentation* (Abstract), comprising:

- *receiving a selection of a plurality of media objects to be included in a media presentation* (column 2, lines 23 – 52 column 6, lines 42 – 50);
- *receiving configuration instructions for ordering the plurality of media objects in the media presentation* (column 6, lines 42 – 50);
- *providing a wireless communication device with an association list that identifies a trigger event to be associated with the media package* (column 5, lines 16 – 23).

It has been interpreted that the providing of predetermined information corresponding to media objects in different manners sufficiently corresponds to providing an ordered sequence of media objects associated with an association list that identifies a trigger event.

Noesgaard does not explicitly disclose generating a media package comprising the selected media objects in said order and transmitting the media package to a wireless communication device.

Nevertheless, in an analogous art, Haller discloses:

- *generating a media package comprising the selected media objects in said order*  
(column 8, lines 3 - 8) *and*
- *transmitting the media package to a wireless communication device* (column 3, lines 28 - 30, column 7, lines 65 - column 8, line 8; column 8, lines 40 - 54; and column 13, lines 16 - 20).

Both Noesgaard and Haller pertain to the analogous art of providing arrangements of multimedia files such as screen savers to mobile phones (Noesgaard, Abstract and Haller, column 2, lines 29 - 53). Therefore, one would look to the other for possible improvements upon their inventions. Furthermore, Haller discloses that, regarding such multimedia arrangements like that of Noesgaard, a user may be interested in having all or some of the multimedia arranged through such means as related themes that may be changed without user intervention (Haller, column 2, lines 17 - 25). Therefore, because it is desirable that such multimedia arrangements be communicated without a request from a user, it would have been obvious to one of ordinary skill in the art at the time of invention to combine the teachings of Haller with the invention of Noesgaard.

#### ***Response to Arguments***

9. Applicant's arguments filed on 9/19/2008 have been fully considered, but are not persuasive.



10. The Applicant has argued that “nowhere does this disclosure even contemplate a trigger event, much less associating a media presentation with trigger event on the first device and then playing the media presentation on the second device in response to the trigger event on the first device.

In response to this argument, The Examiner respectfully disagrees. Please refer to [0011] and [0016] of Kirby, wherein it has been interpreted that the receipt of a command sufficiently serves as a triggering event, because it triggers the display/presentation of content as a response to the received command, further wherein the fact that said commands can be received from remote sources to control the presentation of media on different displays of different devices sufficiently serves to play a media presentation on a second handheld wireless communication device in response to a trigger event on a first handheld wireless communication device

11. Regarding Applicant’s arguments pertaining to the rejection of claims 28 and 29 under 35 U.S.C. 112, paragraph one, the Applicant has argued that “paragraph 54 is describing the system 325 that is embodied in FIG. 7. Paragraph 52 describes certain elements of the device 327 that is part of the system in FIG. 7 and states that the device 325 may have communication links via wireless connection or Internet connection. The next paragraph 53 goes on to describe an embodiment where the configuration utility 340 is used to configure a media presentation. Paragraph 53 also describes an embodiment where the configuration utility is a process operating on a different device and that the media presentation is configured on that different device and

then sent to the device 327 along with an association list that identifies a trigger event to be associated with the media package.”

In response to this argument, the Examiner agrees that the device 325 is able to communicate via wireless/Internet connections and that “the media presentations [may be] configured on [a first] device and then sent to [a second] device along with an association list that identifies a trigger event *to be associated with* the media package.” However, this does not disclose or make obvious the step of “playing the media presentation on the second handheld wireless communication device in response to the trigger event detected on the first handheld wireless communication device,” as claimed in various similar language in claims 28 and 29. This only discloses that said media presentation and said association list that identifies a trigger event to be associated with the media package may be *sent* to a second device from a first device, *not* that said media presentation may be played “on the second handheld wireless communication device in response to the trigger event detected on the first handheld wireless communication device.”

The Applicant has also argued that “paragraph 54 goes on to describe an embodiment whereby a user using the system 325, is able to construct and configure a media presentation and associate that media presentation with a particular trigger event. When the trigger event occurs, the presentation can be displayed locally. However, paragraph 54 goes on to describe that if the device 327 includes communication abilities, which paragraph 52 stated it may have, then the device may publish the media package to a remote device and that the media presentation may be played remotely, with the caveat that the remote device must of course have a properly

configured media engine. Thus, the media presentation can be played locally or played remotely if the device includes communication capabilities.”

In response to this argument, the Examiner agrees that the device 327 (i.e. a first device) may include communication abilities which allow for the presentation of a media package to not only be played/presented locally at said first device, but also that said media package may be published to a remote device (i.e. a second device) to be played remotely at said second device. This does not, however, disclose or make obvious that said media package may be *triggered* remotely, or the step of “playing the media presentation on the second handheld wireless communication device in response to the trigger event detected on the first handheld wireless communication device,” as claimed in various similar language in claims 28 and 29.

In addition, [0051] of the specification describes that “the media package may be used locally or may be published to be used remotely” and that “the media presentation generated on a local device may be published to a remote device for use and presentation.” Furthermore, [0051] describes that upon being published to a remote device, “the remote user associates the media package with *a trigger event* and the remote device monitors for *that trigger event*.” This basically teaches the exact opposite of monitoring for a trigger event occurring on a different device, as essentially claimed in claims 28 and 29, and thus would not lead one to contemplate such a feature.

Therefore, nowhere in the specification is it disclosed or made obvious a step of “playing the media presentation on the second handheld wireless communication device in response to the trigger event detected on the first handheld wireless communication device,” as claimed in

various similar language in claims 28 and 29, and thus Applicant's assertion that "the description of FIG. 7 clearly supports the claim language that requires playing the media presentation on a second device in response to a trigger event detected on the first device," is incorrect and purely speculative.

12. The Applicant has argued that "the specification does in fact support claim language requiring that an association be transmitted along with a media package" and that "new claim 30 is directed toward just such an embodiment," wherein "none of the cited references disclose or even contemplate this particular feature."

In response to this argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "an association be *transmitted* along with a media package") are not recited in the rejected claims. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

### ***Conclusion***

13. It is noted that any citation to specific, pages, columns, lines, or figures in the prior art references and any interpretation of the references should not be considered to be limiting in any way. A reference is relevant for all it contains and may be relied upon for all that it would have reasonably suggested to one having ordinary skill in the art. In *re Heck*, 699 F.2d 1331, 1332-

33,216 USPQ 1038, 1039 (Fed. Cir. 1983) (quoting In re Lemelson, 397 F.2d 1006,1009, 158 USPQ 275, 277 (CCPA 1968)).

*14. The prior art made of record and not relied upon is considered pertinent to the applicant's disclosure. The cited documents represent the general state of the art.*

15. This is a request for continued examination under 37 CFR 1.114 of applicant's application. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eric A. Wiener whose telephone number is 571-270-1401. The examiner can normally be reached on Monday through Thursday from 9am to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Weilun Lo, can be reached on 571-272-4847. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Eric Wiener/  
Examiner, Art Unit 2179

/Ba Huynh/  
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